

REMARKS

This Amendment and the following remarks are intended to fully respond to the Office Action dated January 8, 2007. In that Office Action, the drawings were objected to because, according to the Examiner, “the figures do not show the claimed invention.” *Office Action, Detailed Action*, 1/8/2007 at 6. Claims 6-18, 26 and 27 were examined and all were rejected. Claims 6-18, 26 and 27 were rejected under 35 U.S.C. § 101 because the claimed invention, according to the Examiner, is directed to non-statutory subject matter; claim 9 and its dependent claims were rejected under 35 U.S.C. § 112 as failing to comply with the enablement requirement and as based on a disclosure which is not enabling; claim 6 and its dependent claims, and claims 7, 15-18, and 26-27 were rejected under 35 U.S.C. § 112 as based on a disclosure which, according to the Examiner, is not enabling. Claim 6 and its dependent claims, and claims 8-11, 15-16, and 26-27 were also rejected under 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. In addition, claims 6-13, 26 and 27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,587,835 to Treyz et al. (hereinafter, “Treyz”) in view of “Official Notice;” claim 14 was rejected under 35 U.S.C. 103(a) as being unpatentable over Treyz and “Official Notice” in view of U.S. Patent No. 6,125,385 to Wies et al. (hereinafter, “Wies”); claim 15 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Treyz and “Official Notice” in view of U.S. Patent No. 6,816,878 to Zimmers et al. (hereinafter, “Zimmers”); and claims 16-18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Treyz and “Official Notice” in view of U.S. Patent No. 5,808,907 to Shetty et al. (hereinafter, “Shetty”). Reconsideration of these rejections, as they might apply to the original and amended claims in view of these remarks, is respectfully requested.

In this Response, claims 6, 8-10, 14-16 and 26-27 have been amended, claim 7 has been cancelled, and claims 28-34 have been added. Claims 1-5 remain cancelled, and claims 19-25, previously withdrawn by the Examiner, have been cancelled.

Interview Summary

The Applicants would like to thank Examiner Patel for his time and cooperation in the in-person interview conducted on April 9, 2007 with Applicants’ Representative, Elizabeth Reagan. In the interview, the following were discussed: (1) a short summary of the present invention, as

embodied in the claims; (2) objections to the drawings; (3) claim rejections under 35 U.S.C. § 101; (4) claim rejections under 35 U.S.C. § 112; and (5) claim rejections under 35 U.S.C. § 103, including the cited art and “Official Notice” art and the differences between the present invention, as embodied in the claims, and the cited art. After some discussion regarding the proposed claim amendments and how to classify certain claim terms, the Applicants notified the Examiner that amendments to the claims would likely be provided in the next Amendment & Response for examination. Further, following discussion of the Figures and claim language, the Examiner agreed that the drawings do not require modifications.

Objections to Drawings

According to the Examiner’s most recent Office Action, “New corrected drawings are required in this application because the figures do not show the claimed invention . . . A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application.” *Office Action, Detailed Action*, 1/8/2007 at 6. As discussed during the Examiner Interview conducted on April 9, 2007, the Applicants respectfully disagree that the “figures do not show the claimed invention.” Pursuant to 35 U.S.C. § 113, “The applicant shall furnish a drawing *where necessary for the understanding of the subject matter sought to be patented.*” (Emphasis added.) The Applicants respectfully contend that the Specification shows the claimed invention and that the figures do not require correction to teach the invention as claimed. As noted, the Applicants and the Examiner reviewed the objections to the drawings during the Examiner Interview. Following a discussion regarding clarification of claim terms and an examination of the drawings in relation thereto, the Examiner agreed that no modifications are required to the drawings at this time. As such, the Applicants respectfully request formal withdrawal of the Examiner’s objection to the drawings in light of the Interview conducted on April 9, 2007.

Claim Rejections -- 35 U.S.C. § 101

Claims 6-18, 26 and 27 were rejected under 35 U.S.C. § 101 because the claimed invention, according to the Examiner, is directed to non-statutory subject matter. Specifically, the Examiner states that “claim 6 and its dependent claims are software per se that is not tangibly embodied on a computer storage medium and therefore lacks a practical application because it

alone cannot produce its intended outcome. The specification of this application states, ‘The computer program product may also be a propagated signal on a carrier.’ . . . Claim 6 and their dependent claims do not produce a concrete and tangible result.” *Office Action, Detailed Action*, 1/8/2007 at 7.

As shown above, the Applicants have amended claim 6 to read: “A computer storage medium, program product executable by a computer and encoding instructions” As discussed during the Examiner Interview, the Applicants respectfully do not agree with the Examiner’s reasons for requiring this amendment, but the Applicants have amended the claim in the interest of furthering this application to allowance. Claim 8 was likewise amended to address the Examiner’s concerns. In light of these amendments, claims 6 and 8 are believed to be patentable, and the Applicants respectfully request reconsideration of the rejections to these claims.

In addition, claim 6 and its dependent claims were rejected because “claim 6 and its dependent claims claim a computer program product, however the body of the claims contain process steps.” As discussed *supra*, claim 6 has been amended to read “a computer storage medium, executable by a computer and encoding instructions” Further, as discussed during the Examiner Interview, the Applicants respectfully disagree with this rejection because the United States Patent and Trademark Office has allowed software claims structured as “article of manufacture,” or *Beauregard*, claims. *See In re Beauregard*, 53 F.3d 1583 (Fed. Cir. 1995). Accordingly, the Applicants respectfully request reconsideration of the rejections to claims 6 and 8.

Further, the Examiner rejected claim 9 and its dependent claims because they “do not produce a concrete and tangible result. Determining whether to notify the user using the notification types alone is not producing a tangible result. It’s not until the result of the determining is provided to the user that it becomes a tangible result” *Office Action, Detailed Action*, 1/8/2007 at 7-8. As discussed during the Examiner Interview, the Applicants respectfully disagree with this rejection because “notifying the user of a first notification event using a first notification type” and/or “notifying the user of the first notification event using a second notification type” is the “concrete and tangible result,” or “the result of the determining [which] is provided to the user.” Further, a “concrete and tangible result” is achieved with the amended claim language: “the processing unit utilizing the first or second output unit to notify

the user.” Claim 9 is thus believed to be patentable. In addition, claims 9-15 are also believed to be patentable as these claims depend from the allowable base claim 9.

In light of the amendments presented herein and above discussion, the Applicants respectfully request reconsideration of the rejections to claims 6 and 8-16.

Claim Rejections – 35 U.S.C. § 112: “Enablement”

Claim 9 and its dependent claims were rejected under 35 U.S.C. § 112 as failing to comply with the enablement requirement and as based on a disclosure which is not enabling; and claim 6 and its dependent claims, and claims 7, 15-18, and 26-27 were rejected under 35 U.S.C. § 112 as based on a disclosure which, according to the Examiner, is not enabling. Claim 6 and its dependent claims, and claims 8-11, 15-16, and 26-27 were also rejected under 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention.

Claim 9 and its dependent claims were rejected under § 112 as failing to comply with the enablement requirement because the “claim(s) contains subject matter, which was not described in the specification of this application under examination in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.” The Applicants respectfully disagree with the Examiner that claim 9 fails to comply with the enablement requirement. According to the claim language, a profile is selected and a processing unit determines whether to use a first or second notification type to notify the user based on the association of the profile with the notification mode, events, and/or types. As provided in the Specification, “[E]ach profile may be configured to provide different types of notifications for a plurality of different types of notification-type events. Using the profiles, the small computer device may be set to a predetermined mode, wherein the mode relates to a predetermined notification profile so that each notification is presented to the user in the appropriate manner.” Application at **5-6 (emphasis added). However, in the interest of furthering this application to allowance, the Applicants have amended claim 9 to add the element: “the processing unit utilizing the first or second output unit to notify the user.” The Examiner also argues with respect to claim 9 that “it is not possible to first notify both the notification event using both the notification types and then determining whether to use the first notification type or the second notification type.” *Office Action, Detailed Action*, 1/8/2007 at 9.

As discussed during the Examiner Interview, the Applicants respectfully disagree because the claim language does not state that the notification occurs first before the determining step. Rather, the second and third elements describe the output units for notifying the user once the determining step has occurred. In light of the above amendments and discussion, the Applicants respectfully request reconsideration of the rejections to claim 9 and its dependent claims.

Next, the Examiner argues that claim 6 and its dependent claims are based on a disclosure which is not enabling. Specifically, the Examiner states, “Merely steps, i.e., storing profiles, receiving a signal and applying the selected notification mode cannot support notifying the user of the small computer device of notification events.” As discussed during the Examiner Interview, while the Applicants disagree with this rejection, the Applicants have amended claim 6 to read: “as a result of applying the selected notification mode, notifying the user of notification events in accordance with the notification profile assigned to the selected notification mode.” In light of this amendment, the Applicants respectfully request reconsideration of the rejection to claim 6. Because claim 6 is believed to be patentable, the Applicants also request reconsideration of the rejections to claim 8 because this claim depends upon the allowable base claim 6. Further, the Examiner argues that claim 6 and its dependent claims are rejected as based on a disclosure which is not enabling because “[w]ithout having step involving selection of the notification mode it is not possible to apply anything on the selected notification mode.” The Applicants respectfully disagree because the claim language “applying the selected notification mode to the small computer device” is the step “involving selection of the notification mode.” Accordingly, the Applicants respectfully request reconsideration of the rejections to claims 6 and 8.

With respect to claim 9, the Examiner argues that there is no enablement because “[w]ithout having usage of the stored profiles by the first output device, and second output device it is not possible to have the first output device, and the second output device to notify by themselves.” *Office Action, Detailed Action*, 1/8/2007 at 10. The Applicants respectfully disagree with the Examiner’s reading of this claim language. The output device, or unit, is shown in FIG. 2 as output device 210 and may be any type of output device, such as a display screen which notifies the user of the notification event using a notification type. Thus, the processing unit may use the first or second output unit of claim 9 to notify the user. As discussed during the Examiner Interview, while the Applicants respectfully disagree with this rejection,

claim 9 has been amended for clarification purposes of this concept to read: “the processing unit utilizing the first or second output unit to notify the user.” In light of this amendment and the above discussion, the Applicants respectfully request reconsideration of the rejection to claim 9 and its dependent claims.

The Examiner also rejects claim 9 as not enabling because “[w]ithout having multiple notifications that are notified to the user it is not possible to accomplish ‘notifying a user of notification events.’” *Office Action, Detailed Action*, 1/8/2007 at 11. The Applicants respectfully disagree because the claim language provides that “each notification profile is assigned a predetermined notification mode and such that within each notification profile are notification events such that each of the notification events is assigned at least one notification type.” However, in the interest of furthering this application to allowance, the Applicants have amended element four of claim 9 to read: “a processing unit in response to a profile selected from the plurality of profiles in the memory unit and in response to a notification event, automatically determining” In light of this amendment and the above discussion, the Applicants respectfully request reconsideration of the rejection to claim 9.

In addition, the Examiner rejected claims 15-18 as not enabling because “[w]ithout having limitations that interrelate between the claimed limitations of claim 9 with the claimed limitations of claims 15-18, it is not possible to utilize the limitations of the claims 15-18. The limitations of the claims 15-18 cannot support the user of claim 9 to notify the notification events. For example, claim 15 contain[s] another user and another profile, which has nothing to do with the user of claim 9 to notify the notification events.” *Office Action, Detailed Action*, 1/8/2007 at 11. The Applicants respectfully disagree with the rejection because the language of claim 9 supports the language of claims 15-18. For example, with the example given by the Examiner regarding claim 15, claim 9 refers to “a plurality of notification profiles for each of one or more users.” (Emphasis added). Claim 15’s language “each profile” refers to this language also from claim 9. Similarly, the language of claims 16-18 referring to “a user is capable of being notified of an event in a plurality of ways, depending on a currently selected profile,” is “interrelated” to the language of claim 9 of “a memory unit storing a plurality of notification profiles for each of one or more users, such that each notification profile is assigned a predetermined notification mode and such that within each notification profile are notification

events such that each of the notification events is assigned at least one notification type.” As such, the Applicants respectfully request reconsideration of these rejections to claims 15-18.

Similarly, the Examiner rejected claims 26 and 27 as not enabling because “[t]he limitations of the claims 26 and 27 cannot support the user of claim 9 to notify the notification events. For example, claim 26 contain[s] another selecting a particular notification mode, storing modified profile, which has nothing to do with the profiles used by the user of claim 9 to notify the notification events.” *Office Action, Detailed Action*, 1/8/2007 at 11-12. As the Applicants pointed out during the Examiner Interview, the Applicants respectfully disagree because claims 26 and 27 are dependent upon claim “6,” and not on claim “9.” Assuming that the Examiner intended to refer to claim “6,” the Applicants still disagree with the rejection because the language of claims 26 and 27 is fully supported by the language of claim 6. For example, with the example given by the Examiner, claim 26’s “selecting a particular notification mode” relates to the language of claim 6 of “receiving a selection signal to select one notification mode.” As such, the Applicants respectfully request reconsideration of the rejections to claims 26 and 27.

The Examiner also rejected claim 27 as not enabling for the further reason that “[w]ithout having limitations that contain and provide volume levels, it is not possible to select the volume levels. The ‘volume levels’ cannot exist by itself [sic]. For example, volume levels of the computer device, or volume levels in the user profiles.” *Office Action, Detailed Action*, 1/8/2007 at 12. As discussed during the Examiner Interview, while the Applicants disagree with the Examiner’s reasons for the rejection, the Applicants have amended the claim language of claim 27 in the interest of furthering this application to allowance to read: “assigning a plurality of volume levels of the small computer device with different notification types assigned to notification events within a notification profile.” In light of this amendment, the Applicants respectfully request reconsideration of the rejection to claim 27. Further, the Specification of the application teaches volume levels. For example, it provides:

The normal profile has intermediate volume levels for notifications and does not employ vibration type notification since vibrations tend to consume significant amounts of power. The outside profile has louder volume levels since it can be harder to hear a notification outside. Further, the outside profile employs vibration to further aid the user in recognizing notifications. The meeting profile has volume levels set to silent so that others are not interrupted. Additionally, the meeting profile may also employ vibrations as a notification type that informs the user of an event but does not interfere with the meeting.

Specification at 11.

Accordingly, in light of the amendments and above discussion, the Applicants respectfully request reconsideration of the rejections to claims 6, 8-18 and 26-27.

Claim Rejections – 35 U.S.C. § 112: “Indefinite”

Claim 6 and its dependent claims, and claims 8-11, 15-16, and 26-27 were also rejected under 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention.

Specifically, claim 6 and its dependent claims were rejected for “claiming a computer program product, however the body of the claims contain process steps.” This rejection is discussed above and was discussed during the Examiner Interview. Please see *supra*. In light of the above discussion, the Applicants respectfully request reconsideration of the rejection to claim 6 and its dependent claims.

The Examiner also rejected claim 6 and its dependent claims for reciting the limitation “the selected notification mode” without providing an antecedent basis for such. The Applicants respectfully disagree because the language “to select one notification mode” is the antecedent basis for “the selected notification mode.” As such, the Applicants respectfully request reconsideration of the rejection to claim 6 and its dependent claims.

Also, the Examiner rejected claim 10 for reciting the limitation “the reception of email” without providing an antecedent basis for such. As discussed during the Examiner Interview, while the Applicants respectfully disagree, the Applicants have amended claim 10 in the interest of furthering this application to allowance to read: “a reception of email over a wireless network.” (Emphasis added.) In light of this amendment, the Applicants respectfully request reconsideration of the rejection to claim 10.

The Examiner further rejected claim 10 for reciting the limitation “the notification event” without providing a sufficient antecedent basis. The Applicants respectfully disagree with this rejection because claim 9, the base claim from which claim 10 depends, states, “wherein within each notification profile are notification events and wherein each of the notification events is associated with at least one notification type.” (Emphasis added.) The language of claim 9 supports a single notification event or a plurality of notification events. However, in the interest of forwarding this application to allowance, the Applicants have amended the language of claim

10 to read: “wherein the a type of notification event is” In light of this amendment and the above discussion, the Applicants respectfully request reconsideration of this rejection to claim 10.

With respect to claims 8 and 11, the Examiner rejected these claims because “[t]he specification of this application fails to define what is considered as calendar-type application program and not calendar-type application program.” The Applicants do not understand the Examiner’s reasons for this rejection. Further, the Applicants point out that the Specification of the application defines and discusses the calendar-type application program and calendar-related events in depth. *See, e.g.*, Specification at 3-4, 6, 15, 17-18. For example, page 17 of the Specification defines and describes: “The flow 900 begins when a calendar-related event occurs. Hence, in this embodiment, the small computer device has a calendar-type application capable of storing appointments and other calendar-related items. Moreover, the small computer device has an internal clock system thereby allowing the small computer device to remind the user of upcoming events scheduled in the calendar application.” During the Examiner Interview, the Examiner indicated that the confusion may lie in the use of the “hyphen” in “calendar-type application program.” The Applicants point out that the Specification uses “calendar-type application” both with and without a hyphen, i.e., “calendar type application,” and that these usages are meant to be synonymous and used interchangeably. *See, e.g.*, Specification at 4 (with hyphen) & 15 (without hyphen). Accordingly, the Applicants respectfully request reconsideration of these rejections.

The Examiner also rejected claim 8 for reciting the limitation, “the selection signal for selecting one (without ‘the’ or ‘said’) notification mode.” *Office Action, Detailed Action*, 1/8/2007 at 13. The Applicants respectfully disagree that claim 8 is indefinite. The language “the selection signal for selecting one notification mode” relates to the language of claim 6 of “receiving a selection signal to select one notification mode.” (Emphasis added.) Claim 8 adds the limitation to this language that the selection signal for selecting one notification mode “is generated by the calendar-type application program.” As such, the Applicants respectfully request reconsideration of this rejection to claim 8.

In addition, the Examiner rejected claim 8 for reciting the limitation “program storing reminder events” because “[c]laim 8 is claiming a computer program product, however storing is a step and not even mentioned to be part of the process steps of the claim 6 which the claim 8

depends to.” The Applicant respectfully disagrees. First, please see the discussion above regarding *Beauregard* claims. *See supra*. Second, “storing” is not part of the process steps of claim 6 but instead refers to the calendar-type application program which stores reminder events. Accordingly, the Applicants respectfully request reconsideration of this rejection to claim 8.

The Examiner also rejected claim 8 for reciting the limitation “the computer further comprises” because “[s]ince, multiple computer exists in the claim . . . it is not clear which computer is referred to.” The Applicants respectfully disagree with the Examiner’s reasons for this rejection but have amended the claim in the interest of furthering this application to allowance to add the term “device” for clarification purposes only. Claim 6 expressly refers to “a user of a small computer device.” (Emphasis added.) In light of this amendment, the Applicants respectfully request reconsideration of this rejection to claim 8.

In addition, the Examiner rejected claim 9 for reciting the limitation “the second notification type is different from the first notification type” because “[t]he term ‘different’ in claim 9 is a relative term.” *Office Action, Detailed Action*, 1/8/2007 at 14. As discussed during the Examiner Interview, the Applicants respectfully disagree with the rejection because the claim language provides that the “second” notification type is “different from the “first” notification type. The distinction is between two notification types. Further, the Specification clarifies the meaning of “different” with respect to notification types. *See, e.g.*, Specification at 5 (“An embodiment of the invention provides control of user notifications for different environments through the use of customized notification profiles. Each profile has information related to each type of notification event (such as a meeting reminder, a button press among others) and a corresponding notification type (such as an audible chime, a visual display, among others) for each notification event. Thus, each profile may be configured to provide different types of notifications for a plurality of different types of notification-type events.”). In light of this discussion, the Applicants also disagree with the Examiner’s argument related thereto regarding claim 13. As such, the Applicants respectfully request reconsideration of the rejections of claims 9 and 13.

The Examiner also rejected claim 15 because “[t]he term ‘present’ in claim 9 is a relative term, which renders the claim indefinite. It is not apparent what environment is considered present versus not present.” *Office Action, Detailed Action*, 1/8/2007 at 14. The Applicants respectfully disagree with this rejection. The Specification of the application explains present

environment. *See, e.g.*, Specification at 13 (“Typically, the user selects these volume levels based on an understanding of the environments that the particular profile will be used.”). The environment in which the profile is being used would thus be the “present environment” according to an embodiment of the invention. However, as discussed during the Examiner Interview and in the interest of furthering this application to allowance, the Applicants have amended the language of claim 15 to delete the word “present.” As such, the Applicants respectfully request reconsideration of the rejection to claim 15.

Additionally, the Examiner rejected claim 16 because it recites the limitations “currently” and “[i]t is not apparent what profile is considered currently selected versus not currently selected.” *Office Action, Detailed Action*, 1/8/2007 at 14-15. The Applicants respectfully disagree with this rejection. The Specification of the application provides explanation that the “current” profile would be the existing profile. *See* Specification at 16 (discussing “current” in terms of the distinct “mode,” but stating: “the menu may provide a visual indication to the user relating to the current or existing notification mode, such as a check mark next to the current mode” (emphasis added)). However, as discussed during the Examiner Interview and in the interest of furthering this application to allowance, the Applicants have amended the language of claim 16 to delete the word “currently.” As such, the Applicants respectfully request reconsideration of the rejection to claim 16.

Further, the Examiner rejected claim 16 because it recites the limitation “a user is capable of” and “it is not apparent what other user (without ‘the’ or ‘said’) has to do with the user presented in the claim 9.” *Office Action, Detailed Action*, 1/8/2007 at 15. The Applicant respectfully disagrees with this rejection because claim 15 refers to the language in claim 9 of “notifying a user . . . each of one or more users.” However, in the interest of furthering this application to allowance, the Applicants have amended claim 16 to read: “The computer system as defined in claim 9 wherein each of one or more a users is capable of being notified of an event in a plurality of ways, depending on a ~~currently~~ selected profile.” Accordingly, the Applicants respectfully request reconsideration of the rejection to claim 16.

The Examiner also rejected claim 26 because it recites the limitation “that” and “the modified profile.” The Applicants respectfully disagree with these rejections because “that mode” refers to the immediately preceding language “selecting a particular notification mode to modify a notification profile” However, in the interest of furthering this application to

allowance, the Applicants have amended claim 26 to read: “selecting a particular notification mode to modify a notification profile assigned to that mode.” Further, “the modified profile” has antecedent basis in the language “to modify a notification profile.” Modifying a notification profile would result in a “modified profile.” Accordingly, the Applicants respectfully request reconsideration of the rejection to claim 26.

In addition, the Examiner rejected claim 27 for reciting the limitations “different notification types” because “[c]laim 27 fails to provide what is considered different and what is not considered different.” As discussed during the Examiner Interview, the Applicants respectfully disagree with this rejection because claim 6, the claim from which claim 27 depends, states: “wherein within each notification profile are notification events and wherein each of the notification events is associated with at least one notification type.” (Emphasis added.) Further, the Specification of the application defines “different,” in which it provides, for example, that “[e]ach profile has information related to each type of notification event (such as a meeting reminder, a button press among others) and a corresponding notification type (such as an audible chime, a visual display, among others) for each notification event. Thus, each profile may be configured to provide different types of notifications for a plurality of different types of notification-type events.” Specification at 5 (emphasis added). The Applicants therefore respectfully maintain that given the Specification’s in-depth description and definition of the term “different,” this term is not indefinite in the context of the present invention. As such, the Applicants respectfully request reconsideration of the rejection to claim 27.

Accordingly, in light of the amendments and above discussion, the Applicants respectfully request reconsideration of the rejections to claims 6, 8-18 and 26-27.

Claim Rejections – 35 U.S.C. § 103, Treyz in view of “Official Notice”

Claims 6, 8-13, 26, and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Treyz in view of “Official Notice.” The Applicants respectfully traverse these § 103(a) rejections because the Examiner has failed to state a prima facie case of obviousness. A prima facie case of obviousness can be established only when all of the following requirements are satisfied: (1) the reference or combination of references must teach or suggest all of the claim limitations; (2) there must be some suggestion or motivation in the references themselves to combine the references; and (3) there must be a reasonable expectation of success. *See* MPEP §§

706.02(j) & 2143. Thus, the combination of references cited by the Examiner must teach or suggest every limitation of the claimed invention. *CFMT, Inc. v. YieldUp Int'l Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003); *see also* MPEP § 2143.03.

Treyz relates to a handheld computing device for providing primarily shopping assistance services. With respect to claims 6 and 9, Treyz fails to teach, among other elements: “storing two or more notification profiles for each of one or more users, such that each notification profile is assigned a predetermined notification mode from a selection of one or more notification modes such that each notification profile has one or more notification events and such that each of the notification events is assigned at least one notification type from a selection of one or more notification types.” Treyz fails to disclose, for example, storing notification profiles for users where each notification profile has notification events and associated notification types programmed or stored for a particular notification mode, such as “Meeting,” “Outside,” etc. Indeed, the Examiner admits:

Treyz do not specifically mention about notification profiles and each notification profile (note: without ‘said’ or ‘the’ not necessarily the same profile mentioned earlier) is associated with a predetermined notification mode and wherein within each notification profile (note: without ‘said’ or ‘the’ not necessarily the same profile mentioned earlier) are notification events and each of the notification events is associated with a notification type.

Office Action, Detailed Action, 1/8/2007 at 19 (emphasis added).

In fact, the Examiner admitted the same in the previous Office Action, dated May 17, 2006. *See* Office Action, 05/17/2006, at 11. However, the Examiner states that “‘Official Notice’ is taken that both the concept and advantages of providing notification profiles and each notification profile is associated with a predetermined notification mode and wherein within each notification profile are notification events and each of the notification events is associated with a notification type(s) is well known and expected in the art. For example, Hunter et al., 6,850,901 discloses these limitations, col., 11, line 13 - col., 13, line 53. Shteyn et al., 6,782, 253 discloses these limitations, col., 3, line 1 - col., 4, line 45, Chen et al., 2002/0177453, paragraphs 100-102.” *Office Action, Detailed Action*, 1/8/2007 at 19-20. The Examiner further states that “[i]t would have been obvious . . . to include notification profiles and each notification profile is associated with a predetermined notification mode and wherein within each notification profile are notification events” *Id.*

However, the Applicants respectfully disagree that it would have been obvious to have notification profiles associated with notification modes, notification events, and notification types. It is well-established that the teachings of a present invention may not be used as a roadmap to combine pieces of art. As such, there is no teaching in the cited references of, among other elements, a notification profile assigned a predetermined notification mode from a selection of one or more notification modes such that each notification profile has one or more notification events, and such that each of the notification events is assigned at least one notification type from a selection of one or more notification types.

Moreover, as discussed during the Examiner Interview, the art listed as “Official Notice” by the Examiner does not teach the notification profiles, modes, notification events, and notification types of the present invention. First, the Examiner cites “Chen et al., 2002/0177453, paragraphs 100-10;” however, the filing date of this reference is May 10, 2001, *after* the filing date of the present invention. Chen is thus not prior art and may not be used as “Official Notice.” Second, the Examiner cites “Hunter et al., 6,850,901 discloses these limitations, col., 11, line 13 - col., 13, line 53” and “Shteyn et al., 6,782, 253” as disclosing the concept of profiles. However, these references do not disclose the notification profiles claimed by the present invention. Hunter relates to an automated order processing system where a caller is routed to the appropriate merchant based on a product order number entered by the caller. Hunter nowhere mentions storing notification profile(s) and associating such notification profile(s) with selected mode(s) and corresponding notification event(s) and notification type(s). Similarly, Shteyn does not disclose storing notification profile(s) for associating notification modes with notification event(s) and notification type(s). While Shteyn allows a user to program a user-profile, this profile is not the notification profile claimed by the present invention. The user-profile of Shteyn does not relate to notification event(s) and notification type(s) based on the notification mode, or environment, of the user. Instead, Shteyn’s user-profile is used to filter the services or information received by a user. For example, Shteyn describes: “[A] profile is stored that determines what kind of service the user can access, or settings to reject some kinds of call or messages when the user is at work.” *See* Shteyn at col. 10, ll. 57-60. First, Shteyn nowhere teaches the notification profile(s) and associated notification event(s) and notification type(s) of the present invention. Second, in filtering services and events in and of themselves, Shteyn teaches away from the present invention’s purpose of notification of the user of

notification event(s). In accordance with an embodiment, the present invention teaches controlling or adjusting the form of notification, and not the rejection of those events altogether. Accordingly, Shteyn nowhere teaches notification profiles associated with notification events and notification types. Merely because Shteyn uses the terminology “profiles,” its use of this term is thus distinct from the use of this term in the claims of the present invention. As such, Shteyn does not teach, among other claims and elements, the present invention’s notification profile(s) for each of one or more users, such that each notification profile is assigned a predetermined notification mode from a selection of one or more notification modes such that each notification profile has one or more notification events and such that each of the notification events is assigned at least one notification type from a selection of one or more notification types. Accordingly, Hunter and Shteyn fail to teach or disclose the present invention’s notification profile(s) and associated notification event(s) and notification type(s).

For at least the above reasons, the Applicants respectfully request reconsideration of the rejections to claims 6 and 9. These claims are believed to be patentable. In addition, claims 8, 10-13, 26-27, and 28-34 are also believed to be patentable as these claims depend from the allowable base claims 6 and 9.

Claim Rejections – 35 U.S.C. § 103, Treyz and “Official Notice” in view of Wies

Claim 14 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Treyz and “Official Notice” in view of Wies. Because claim 14 depends from what the Applicant believes is an allowable base claim 9, *see* discussion *supra*, claim 14 is believed to be patentable over Treyz and “Official Notice” in view of Wies. The Applicants thus respectfully request reconsideration of the rejection to claim 14 in light of the arguments presented above. Any remaining arguments supporting the rejection of claim 14 are not acquiesced to even though they are not addressed herein.

Claim Rejections – 35 U.S.C. § 103, Treyz and “Official Notice” in view of Zimmers

Claim 15 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Treyz and “Official Notice” in view of Zimmers. Because claim 15 depends from what the Applicants believe is an allowable base claim 9, *see* discussion *supra*, claim 15 is believed to be patentable over Treyz and “Official Notice” in view of Zimmers. The Applicants thus respectfully request

reconsideration of the rejection to claim 15 in light of the arguments presented above. Any remaining arguments supporting the rejection of claim 15 are not acquiesced to even though they are not addressed herein.

Claim Rejections – 35 U.S.C. § 103, Treyz and “Official Notice” in view of Shetty

Claims 16-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Treyz and “Official Notice” in view of Shetty. Because claims 16-18 depend from what the Applicant believes is an allowable base claim 9, *see* discussion *supra*, claims 16-18 are believed to be patentable over Treyz in view of Shetty. The Applicants thus respectfully request reconsideration of the rejections to claims 16-18 in light of the arguments presented above. Any remaining arguments supporting the claim rejections are not acquiesced to even though they are not addressed herein.

Conclusion

This Amendment and Response fully responds to the Office Action mailed on January 8, 2007. It is recognized that the Office Action may contain arguments and rejections that are not directly addressed by this Amendment and Response due to the fact that they are rendered moot in light of the preceding arguments in favor of patentability. Hence, the failure, if any, of this Amendment and Response to directly address an argument raised by the Examiner should not be interpreted as reflecting the Applicants’ belief that such argument has merit. Furthermore, the claims of the present application may include other elements, not discussed in this Amendment and Response, which are not shown, taught, or otherwise suggested by the art of record. Accordingly, the preceding arguments in favor of patentability are advanced without prejudice to other bases of patentability.

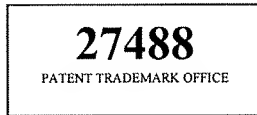
It is believed that no further fees are due with this Amendment and Response. However, the Commissioner is hereby authorized to charge any deficiencies or credit any overpayment with respect to this patent application to deposit account number 13-2725.

In light of the above remarks and amendments, it is believed that the application is now in condition for allowance, and such action is respectfully requested. Should any additional issues need to be resolved, the Examiner is requested to telephone the undersigned to attempt to resolve those issues.

Application No. 09/741,571

Respectfully submitted,

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